

ICCS Rec'd CT/PTO 16 SEP 2005

#6

PATENT  
Attorney Docket No. 49506.0007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Robins et al.

Serial No.: 10/529,106

Filed: March 25, 2005

For: METHOD FOR THE PREPARATION OF 2'-  
HALO-2'-DEOXYADENOSINE COMPOUNDS FOR 2'-  
DEOXYGUANOSINE

Examiner: Unknown

Group Art Unit: Unknown

RECEIVED

11 JAN 2006

Legal Staff  
International Division

**RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS**

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

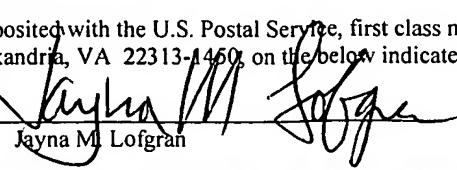
In response to the Notification of Missing Requirements, mailed July 15, 2005, Applicants respectfully request that the USPTO withdraw the Notification of Missing Requirements issued for the above-referenced patent application, since the basis for the notice – namely, (1) that the Oath or declaration is allegedly missing, and (2) that this application does not contain, as a separate part of the disclosure on paper copy, a Sequence Listing – is in error.

With respect to item (1), Applicants have, in fact, already submitted an oath and declaration for each of the named inventors. An oath or declaration is only required if not previously submitted in the international application.

**CERTIFICATE OF MAILING**

I hereby certify the items listed above as enclosed are being deposited with the U.S. Postal Service, first class mail, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below indicated date.

Date: September 14, 2005

Signature:   
Name: Jayna M. Lofgran

(c)(1) . . . [T]he Office will notify the applicant if he or she has omitted any of:

\* \* \*

(ii) The oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1,497, *if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application* under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26<sup>ter</sup>.1

37 CFR § 1.495(c)(1)(ii) (emphasis added).

As indicated in the attached copy of the Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371, an oath or declaration of the inventors was previously submitted on January 9, 2004, in the priority application, International Application No. PCT/US2003/030386. Also submitted herewith is a copy of the Declaration that was previously filed on January 9, 2004, signed by all inventors.

With respect to item (2), Applicants respectfully submit that no sequence listing is required to be filed. No nucleic acid or amino acid sequence is disclosed or claimed in the present application. Accordingly, no sequence listing is required to be filed.

Since the Notification of Missing Requirements was based on an error on the part of the USPTO, and through no fault of the Applicants, no fee should be required. However, in the event a fee is required, Applicants hereby authorize the USPTO to charge the required fee to Deposit Account No. 08-2623. A duplicate copy of this petition is attached for this purpose.

Respectfully submitted,



Christopher L. Wight, Reg. No. 31,680  
HOLLAND & HART LLP  
555 - 17<sup>th</sup> Street, Suite 3200  
Denver, Colorado 80201  
Telephone: (801) 595-7823  
Facsimile: (801) 364-9124

Date: September 14, 2005

CLW/jml

Enclosures: Copy of Notification of Missing Requirements  
Copy of Transmittal Letter  
Copy of Declaration

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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/529,106	Morris J Robins	49506.830001.US1 (0007)

INTERNATIONAL APPLICATION NO.

PCT/US03/30386

IA. FILING DATE

09/25/2003

PRIORITY DATE

09/25/2002

Holland & Hart  
 55517th Street  
 Suite 3200  
 Denver, CO 80201-8749

Mail Ledger	7-21-05
Docketed by	mc
Due Date	9-15-05
Client Matter	49506.830001.US1

CONFIRMATION NO. 1963

371 FORMALITIES LETTER



\*OC000000016534886\*

Date Mailed: 07/15/2005

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 03/25/2005
- Copy of the International Search Report filed on 03/25/2005
- Preliminary Amendments filed on 03/25/2005
- Request for Immediate Examination filed on 03/25/2005
- U.S. Basic National Fees filed on 03/25/2005
- Substitute Specification filed on 03/25/2005
- Priority Documents filed on 03/25/2005

09/22/2005 ATRAN1 00000131 082623 10529106

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JUL 26 2005

Holland &amp; Hart LLP

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$130 Surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required.

## SUMMARY OF FEES DUE:

Total additional fees required for this application is \$130 for a Large Entity:

- \$130 Late oath or declaration Surcharge.
- This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c) Applicant must provide an initial paper or compact disc copy of the

"Sequence Listing", as well as an amendment directing its entry into the application and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000).

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

**For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:**

- For Rules Interpretation, call (571) 272-0951
- For Patentin Software Program Help, call Patent EBC at 1-866-217-9197 or directly at 703-305-3028 / 703-308-6845 between the hours of 6 a.m. and 12 midnight, Monday through Friday, EST.
- Send e-mail correspondence for Patentin Software Program Help @ [ebc@uspto.gov](mailto:ebc@uspto.gov)

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

BARBARA A CAMPBELL

Telephone: (703) 308-9140 EXT 217


**PART 1 - ATTORNEY/APPLICANT COPY**

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/529,106	PCT/US03/30386	49506.830001.US1 (0007)

<b>TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371</b>		<b>ATTORNEY'S DOCKET NUMBER 49506.830001.US1 (0007)</b>	
<b>INTERNATIONAL APPLICATION NO. PCT/US2003/030386</b>		<b>INTERNATIONAL FILING DATE 25 September 2003</b>	<b>PRIORITY DATE CLAIMED 25 September 2002</b>
<b>TITLE OF INVENTION METHOD FOR THE PREPARATION OF 2-HALO-2'-DEOXYADENOSINE COMPOUNDS FOR 2'-DEOXYGUANOSINE</b>			
<b>APPLICANT(S) FOR DO/EO/US: Morris J. Robins, Zlatko Janeba, and Paula Francom</b>			
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:			
1. <input checked="" type="checkbox"/> This is a <b>FIRST</b> submission of items concerning a submission under 35 U.S.C. 371.			
2. <input type="checkbox"/> This is a <b>SECOND</b> or <b>SUBSEQUENT</b> submission of items concerning a submission under 35 U.S.C. 371.			
3. <input checked="" type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.			
4. <input checked="" type="checkbox"/> The US has been elected (Article 31).			
5. <input checked="" type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371(c)(2))			
a. <input type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau).			
b. <input type="checkbox"/> has been communicated by the International Bureau.			
c. <input checked="" type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US).			
6. <input checked="" type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).			
a. <input type="checkbox"/> is attached hereto			
b. <input checked="" type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4).			
7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3)).			
a. <input type="checkbox"/> are attached hereto (required only if not communicated by the International Bureau).			
b. <input type="checkbox"/> have been communicated by the International Bureau.			
c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired.			
d. <input type="checkbox"/> have not been made and will not be made.			
8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).			
9. <input checked="" type="checkbox"/> An oath or declaration of the inventor (s) (35 U.S.C. 371 (c)(4)) <b>(previously submitted on January 9, 2004).</b>			
10. <input type="checkbox"/> An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).			
11. <input type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98.			
12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.			
13. <input checked="" type="checkbox"/> A preliminary amendment.			
14. <input type="checkbox"/> An Application Data Sheet under 37 CFR 1.76.			
15. <input type="checkbox"/> A substitute specification.			
16. <input checked="" type="checkbox"/> A power of attorney and/or change of address letter <b>(previously submitted September 25, 2003).</b>			
17. <input type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821-1825.			
18. <input type="checkbox"/> A second copy of the published International Application under 35 U.S.C. 154(d)(4).			
19. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).			
20. <input checked="" type="checkbox"/> Other items or information: <b>Certificate of Mailing (EV 357959521 US)</b>			

This collection of information is required by 37 CFR 1.414 and 1.491-1.492. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313.140.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

U.S. APPLICATION NO. (if known, see 37 CFR 1.5)		INTERNATIONAL APPLICATION NO. <b>PCT/US2003/030386</b>		ATTORNEY'S DOCKET NUMBER <b>49506.830001.US1 (0007)</b>	
The following fees have been submitted				Calculations	Office use only
21. <input checked="" type="checkbox"/> Basic national fee.....\$300				\$ 300.00	
22. <input checked="" type="checkbox"/> Examination fee If International preliminary examination report prepared by USPTO and all claims satisfy provisions of PCT Article 33(1)-(4).....\$100 All other situations.....\$200				\$ 200.00	
23. <input checked="" type="checkbox"/> Search fee Search fee (37 CFR 1.445(a)(2)) has been paid on the international application to the USPTO as an International Search Authority.....\$100 International Search Report prepared and provided to the Office.....\$400 All other situations.....\$500				\$ 100.00	
<b>TOTAL OF 21, 22 and 23 =</b>				<b>\$ 600.00</b>	
<input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing or computer program listing filed in an electronic medium). The fee is \$250.00 for each additional 50 sheets of paper or fraction thereof					
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof (round up to a whole number)	Rate		
-100 =	/50 =		x \$250.00	\$	
Surcharge of \$130.00 for furnishing the oath or declaration later than 30 months from the earliest claimed priority date (37 CFR 1.492(e)).				\$	
CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE	\$	
Total Claims	6 - 20 =	0	x \$50.00	\$	
Independent Claims	6 - 3 =	3	x \$200.00	\$ 600.00	
MULTIPLE DEPENDENT CLAIM(S) (if applicable)			+ \$360.00	\$	
<b>TOTAL OF ABOVE CALCULATION =</b>				<b>\$1,200.00</b>	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2.				\$	
<b>SUBTOTAL =</b>				<b>\$</b>	
Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest priority date (37 CFR 1.492(f)).				\$	
<b>TOTAL NATIONAL FEE =</b>				<b>\$</b>	
Fee for recording the enclosed assignment (37 CFR 1.21 (h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property				\$	
<b>TOTAL FEES ENCLOSED</b>				<b>\$1,200.00</b>	
				Amount to be refunded	\$
				Amount to be charged	\$
a. <input checked="" type="checkbox"/> A check in the amount of <u>\$1,200.00</u> to cover the above fees in enclosed. b. <input type="checkbox"/> Please charge my Deposit Account No. <u>08-2623</u> in the amount of \$_____ to cover the above fees. A duplicate copy of this sheet is enclosed. c. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. <u>08-2623</u> . A duplicate copy of this sheet is enclosed. d. <input type="checkbox"/> Fees are to be charged to a credit card. <b>WARNING:</b> Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.					
<b>NOTE:</b> Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.					
SEND ALL CORRESPONDENCE TO:					
 SIGNATURE					
<u>Christopher L. Wight</u> NAME					
<u>31.680</u> REGISTRATION NUMBER					